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In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 496

KENNETH B. THOMPSON, *Petitioner*

v.

CHARLES H. LEARNED

On Petition for a Writ of Certiorari to the United States Court of Customs and Patent Appeals

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BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the Board of Interference Examiners (R. 613-635) is unreported. The opinion of the Court of Customs and Patent Appeals (R. 687-700) is reported at 191 F. 2d 409.

JURISDICTION

The decision of the Court of Customs and Patent Appeals was entered on June 29, 1951 (R. 700-701).

A petition for rehearing was denied on September 28, 1951 (R. 717). The petition for a writ of certiorari was filed on December 27, 1951. Petitioner invokes the jurisdiction of this Court under 28 U.S.C. 1256.

QUESTION PRESENTED

Whether this Court has jurisdiction to issue a writ of certiorari to review a decision of the Court of Customs and Patent Appeals awarding priority of invention to respondent.

STATUTES INVOLVED

The pertinent parts of the statutes involved are set forth in the Appendix, *infra,* pp. 8-10.

STATEMENT

This is an action arising out of an interference proceeding set up in the Patent Office to determine the priority of invention among the patent applications of four parties, each claiming to be the original and first inventor of a signalling device.[1]

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[1] The present interference is a consolidation of Interference No. 82,373 which involved petitioner, respondent, and the parties Richard S. Hunter, an employee of the Bureau of Standards, and Larry L. Young; and Interference No. 83,032 which originally involved the same parties with the exclusion of Young (R. 612). Judgment was entered against Young in view of his failure to take testimony (R. 58); Hunter filed an abandonment of the contest before the taking of testimony (R. 56-57). The United States has a non-exclusive license under respondent's application under which it assumed the prosecution of his application.

The Board of Interference Examiners of the United States Patent Office awarded priority of invention of the subject matter to petitioner (R. 613-628), with one member dissenting (R. 629-635). On appeal to the United States Court of Customs and Patent Appeals, the decision of the Board of Interference Examiners was reversed and priority of invention awarded to respondent (R. 687-700).

ARGUMENT

The decision of the court below awarding priority of invention to respondent, depending as it does upon the evaluation of testimony and presumptions, is, for the reasons set forth in the court's opinion (R. 687-700), clearly correct and does not warrant review by this Court. Moreover, this Court has long held that it has no constitutional power to review decisions of the lower appellate courts in summary appeals taken under R. S. 4911-4914, *infra*, pp. 8-10, from decisions of the Patent Office in patent and trademark cases.

In the leading case of *Postum Cereal Company* v. *California Fig Nut Company*, 272 U. S. 693 (a trademark case), this Court held that a decision of the Court of Appeals of the District of Columbia in a summary appeal taken from a decision of the Patent Office was "not a judicial judgment," but was "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes" (pp. 698-699). Consequently, such a proceeding was con-

sidered not to be a case or controversy, in the constitutional sense, which this Court was authorized to review.

Subsequent to the decision in the *Postum Cereal Company* case, authority to determine summary appeals taken from decisions of the Patent Office in patent and trademark matters under R. S. 4911-4914 was transferred from the Court of Appeals of the District of Columbia to the newly named Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, 45 Stat. 1475-1476, *infra*, p. 8.[2] After the transfer of this authority to the Court of Customs and Patent Appeals had taken place, this Court in denying, for want of jurisdiction, petitions for writs of certiorari to that court in *Pacific Northwest Canning Company* v. *Skookum Packers' Ass'n*, 283 U. S. 858 (a trademark case), and *McBride* v. *Teeple*, 311 U. S. 649 (a patent case), cited the *Postum Cereal Company* case as authority for its denial of the writs, thus affirming its prior holding that it had no jurisdic-

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[2] The Court of Customs and Patent Appeals may properly be given authority to determine both justiciable and non-justiciable matters. *Ex parte Bakelite Corp.*, 279 U. S. 438. In this connection, summary appeals in patent and trademark matters are to be distinguished from appeals taken to the Court of Customs and Patent Appeals from judgments of the United States Customs Court entered in customs cases. The latter are unquestionably judicial in character and are reviewable by this Court. See, *e. g.*, *Barr* v. *United States*, 324 U. S. 83; *Board of Trustees of University of Illinois* v. *United States*, 289 U. S. 48.

tion to review decisions in summary appeals taken from Patent Office determinations in patent and trademark matters.[3]

Petitioner invokes 28 U. S. C. 1256, *infra*, p. 8, to sustain the jurisdiction of this Court to grant the writ of certiorari and review the decision of the court below. Section 1256 is a part of the Act of June 25, 1948, 62 Stat. 869, codifying into law Title 28 of the United States Code. Prior to the effective date of the 1948 Act, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was Section 195 of the Judicial Code as amended.[4] That section, which empowered the Court of Customs and Patent Appeals to hear appeals from the Customs Court and authorized this Court to review the decisions of the Court of Customs and Patent Appeals in such cases, related only to customs cases. It did not refer to either patent or trade-

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[3] Petitioner's reliance (Pet 2) on *Magnum Co.* v. *Coty*, 262 U. S. 159; *Clifton* v. *United States*, 4 How. 242; and *Electric Storage Battery Co.* v. *Shimadzu*, 307 U. S. 5, as sustaining the jurisdiction of this Court in the instant case, is entirely misplaced. Those cases did not involve summary appeals taken under R. S. 4911-4914 from decisions of the Patent Office to the Court of Customs and Patent Appeals or its predecessor in such matters. They all involved normal appeals which had been taken from judgments and decrees of United States District Courts, and are thus plainly inapposite.

[4] Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U. S. C. (1946 ed.) 308.

mark matters. In the Act of June 25, 1948, Congress merely separated the two provisions—placing in 28 U. S. C. 1541 the authority of the Court of Customs and Patent Appeals to hear appeals in customs cases, and in Section 1256 the authority of this Court to review by writ of certiorari cases in the Court of Customs and Patent Appeals. Nothing in the 1948 Act, codifying into law Title 28 of the United States Code, or its history indicates that there was any intention on the part of Congress to give this Court authority to review a class of cases over which its jurisdiction had previously been withheld, or to diminish the ambit of the *Postum Cereal Company* case.

For a fuller discussion of this Court's lack of jurisdiction to review decisions in summary appeals taken from decisions of the Patent Office in patent and trademark matters, including a brief history of such appeals, and for citations of other cases wherein this Court has declined to review such decisions, we respectfully refer the Court to the respondent's Brief in Opposition (pp. 3-9) in the case of *Dalton and Cooley* v. *Marzall, Commissioner of Patents,* No. 87, this Term, certiorari denied, 342 U. S. 818.

CONCLUSION

It is respectfully submitted that, for the reasons stated above and in the respondent's Brief in Opposition in *Dalton and Cooley* v. *Marzall, supra,* the petition for a writ of certiorari should be

denied for want of jurisdiction as in *McBride* v. *Teeple*, 311 U. S. 649.[5]

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FEBRUARY 1952.

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[5] It would be helpful in the future disposition of cases of this class if this Court, in disposing of the instant case, would indicate whether or not it has jurisdiction to review decisions of the Court of Customs and Patent Appeals in such cases.

APPENDIX

Act of March 2, 1929, c. 488, 45 Stat. 1475-1476:

> That the title of the United States Court of Customs Appeals, created by the Act approved August 5, 1909, is hereby changed to the United States Court of Customs and Patent Appeals.
>
> Sec. 2(a) The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

28 U. S. C. 1256:

> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

Section 4911 R. S., as amended, 27 Stat. 436, 44 Stat. 1335, 1336; 45 Stat. 1476; 53 Stat. 1212; 35 U. S. C. 59a:

> Sec. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may

appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

Section 4914 of the Revised Statutes, 35 U. S. C. 62:

The court [Court of Customs and Patent Appeals], on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall

govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

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